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September 5, 2006

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Number of pages (including this page): **34**

Telephone No.:

From: **H. D. Switzer**

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Operator's initials

CAM No.: **626220-510021**

Re: **USSN 10/784,459**

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Message:

Attached Petition to the Director of Technology Center 3680 Under 37 CFR §1.181(3).

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I hereby certify that this correspondence is being facsimile transmitted to the Director of Technology Center 3680 (Fax No. 571-273-8300) on September 5, 2006

H. Duane Switzer
H. Duane Switzer

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PTO/SB/21 (07-06)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 34

Application Number	10784,459
Filing Date	February 23, 2004
First Named Inventor	Allan Charles Webb
Art Unit	3882
Examiner Name	Director of TC 3880
Attorney Docket Number	626220-510-021

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<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input checked="" type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	Remarks	

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name			
Signature	<i>H Duane Switzer</i>		
Printed name	H. Duane Switzer	Phone	216-586-7283
Date	September 5, 2006	Reg. No.	22,431

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	<i>H Duane Switzer</i>		
Typed or printed name	H. Duane Switzer	Date	September 5, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2005		Complete if Known Application Number 10/784,459 Filing Date February 23, 2004 First Named Inventor Allan Charles Webb Examiner Name Director of TC 3680 Art Unit 3682 Attorney Docket No. 626220510021	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		RECEIVED CENTRAL FAX CENTER SEP 05 2006	
TOTAL AMOUNT OF PAYMENT (\$)			

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 501432 Deposit Account Name: Jones Day

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____				

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): _____

Fees Paid (\$)

SUBMITTED BY

Signature	<i>H Duane Switzer</i>	Registration No. (Attorney/Agent) 22,431	Telephone 216-586-7283
Name (Print/Type)	H. Duane Switzer		Date September 5, 2006

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1460, Alexandria, VA 22313-1460.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/784,459 Confirmation No. 8229
Applicants : Allan Charles Webb et al.
Filed : February 23, 2004
Title : COMPONENT ASSEMBLY WITH FORMED
SPINDLE END PORTION
Art Unit : 3682
Examiner : Lenard A. Footland
Attorney Docket No. : 626220510021
Customer No. : 24325

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H. Duane Switzer
H. Duane Switzer

PETITION TO THE DIRECTOR OF TECHNOLOGY CENTER 3680
(Under 37 CFR § 1.181(3))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Director is requested to exercise his supervisory authority as follows:

1. To instruct the Examiner that 37 CFR § 41.31 does not "overrule" the precedential opinion in *Ex Parte Lemoine*, 46 USPQ2d 1420 (Bd. Pat. App. & Int. 1994).
2. To instruct the Examiner to withdraw his denial of Applicants' right to appeal.

CLI-1447187v1

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STATEMENT OF FACTS

Claims to the same subject matter in the present application and in two parent applications have been rejected five times on the identical grounds.

This application is a continuation of Serial No. 10/195,025 filed July 11, 2002, which in turn is a continuation of Serial No. 09/446,671 filed December 23, 1999. The original U.S. filing is based on PCT/GB98/01823 filed June 22, 1998, which in turn is based on British Serial No. 9713343.3 filed June 24, 1997.

The first Office Action in this continuation application is dated October 31, 2005, and rejected claims 61-76, 80 and 81 under 35 U.S.C. §112, ¶1 & 2, and under 35 U.S.C. §102(e) on U.S. Patent No. 5,490,732 to Hofmann et al.

Applicants appealed the rejection after the first Office Action as permitted by 35 U.S.C. §134(a) because claims to the same subject matter in the two parent applications had been rejected on the identical grounds. The Notice of Appeal was filed on January 30, 2006, and the Appeal Brief was filed on March 29, 2006.

In an Office Action dated June 6, 2006, more than five months after the filing of the Notice of Appeal, the Examiner indicated that the appeal was premature because none of the claims had been twice rejected. The Examiner's comments are as follows:

"The reply filed on 3-29-06 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): None of applicant's claims has been twice rejected. The appeal brief is thus premature. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a)." (Emphasis in original)

On June 9, 2006, Applicants faxed to the Examiner a Request for Reconsideration and Clarification of the denial of Applicants' right to appeal, and cited *Lemoine*. In a later telephone conversation, the Examiner indicated that the Request would be denied because there was no claim comparison showing that the rejected claims in this application were the "same" as the finally rejected claims in the parent application. The Examiner indicated by telephone that "same" meant "identical." The Examiner subsequently telephoned to indicate that 37 CFR §41.31 was effective as of September 13, 2004, whereas the precedential opinion in *Lemoine* is dated December 27, 1994, and that *Lemoine* is "superseded" by 37 CFR §41.31.

On July 28, 2006, Applicants faxed to the Examiner and to the SPE for Technical Center 3682 a Supplemental Request for Reconsideration and Clarification. The same request was faxed to Central Delivery on August 9, 2006. This request argued that *Lemoine* was not superseded by 37 CFR §41.31.

In an Advisory Action dated August 14, 2006, the Examiner denied Applicants' Requests as follows:

"AS EXPLAINED TO ATTY IN A COURTESY CALL SOME TIME AGO, THE EXAMINER'S POSITION IS THAT THE CITED PORTION OF LEMOINE THAT STATES THAT THERE NEED NOT BE THE SAME CLAIM REJECTED TWICE WAS AN ERRONEOUS INTERPRETATION OF THE STATUTE THAT WAS IN EFFECT OVERRULED BY THE SUBSEQUENT CLARIFYING RULE 41.31(A)(2) [Sic. 41.31(a)(1)], PROMULGATED 9-13-04, CLARIFYING THE STATUTE, AND REQUIRING THAT AT LEAST 'ANY', (WHICH THE EXAMINER CONSIDERS TO MEAN 'ANY ONE SAME') CLAIM REJECTED TWICE IS A PREREQUISITE FOR APPEAL. THE APPLICANT MAY PETITION OR APPEAL THIS DETERMINATION BY THE EXAMINER, AS HE FEELS BEST."

On August 30, 2006, Applicants faxed a second Supplemental Request for Reconsideration and Clarification to the Examiner and to Central Delivery. In a telephone

conversation on August 31, 2006, the Examiner indicated that he had looked at this Request, and that his position remained as stated in the Advisory Action of August 14, 2006. Copies of the three Requests for Reconsideration and Clarification that were faxed to the Examiner are attached as TABS D, E and F.

Ex Parte Lemoine

The *Lemoine* opinion is designated as precedential on the issue of the construction of 35 U.S.C. §134. It is understood that under the Standard Operating Procedures of the Board of Patent Appeals and Interferences, an opinion cannot be designated as precedential without approval of the Director of the U.S. Patent and Trademark Office.

Lemoine concerned a continuation application in which a preliminary amendment had been filed to insert new claims and to amend claims that had been finally rejected in the parent application. The applicant appealed after the first Office Action in the continuation application “essentially repeated the three grounds of rejection” that had been made in the parent application. The examiner held the application abandoned on the grounds that an appeal was improper after the first Office Action.

The Board construed 35 U.S.C. §134 as permitting an applicant to appeal when he had been twice denied a patent:

“Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed.” *Lemoine* at 1423

The Board specifically addressed the issue of whether the claims in the parent and continuation applications had to be the same:

“The dissent also errs in construing ‘any of whose claims has been twice rejected’ to means ‘any of whose claims, which do not differ in substance and scope from previously rejected claims, has been

twice rejected.' There is simply no support for this limited view in the statute." *Lemoine at 1423*

The concurring opinion by Judge Stoner on the issue of the construction of 35 U.S.C.

§134 is instructive:

"That no claim, including none of claims 24 through 52, has retained identical wording through two separate Office actions should not and does not, in my view, deprive Lemoine of his right to appeal from the Office action mailed July 17, 1992."

"Where, as here, the examiner's rejection (and underlying evidence in the form of references) remains unchanged through at least two actions on the merits, despite amendments to the claims, there is no reasonable purpose served by forcing an applicant like Lemoine to request reconsideration without further amendment prior to exercising the right to appeal conferred by 35 U.S.C. §134. In my view, to read the statute as though it requires this futile act ill serves the applicant, for whom the right of appeal has been created by statute. Additionally, such a reading departs from a common sense understanding of what 'any of whose claims has been twice rejected' means in this context."

Counting the initial and final Office Actions in the two parent applications, and the initial Office Action in the present application, claims to the same subject matter have been rejected five times on the same grounds, and the application is ripe for appeal.

OVERRULING OF *LEMOINE* BY 37 CFR §41.31

35 U.S.C. §134(a) provides in part:

"An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences,...."

The relevant portion of 35 U.S.C. §134 is quoted in *Lemoine* at page 1422 as follows:

"An applicant for a patent, any of whose claims have [sic.] been twice rejected. May appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences...."

The word “have” is a misprint, and the relevant language is properly quoted following the above passage in *Lemoine* as follows:

“Jurisdiction for this appeal depends on whether appellant is an applicant ‘any of whose claims has been twice rejected.’ “

See attached TABS A and B for reproductions of 35 U.S.C. §134 that was in effect at the time of the *Lemoine* decision.

37 CFR §41.31(a)(1) provides in part:

“Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal....”

The Examiner’s contention that 37 CFR §41.31(a)(1) overrules *Lemoine* is disingenuous. The fact is that the relevant language, “any of whose claims has been twice rejected”, is identical in the Statute and in the Rule, and there is not a shred of evidence to suggest that the Rule overrules *Lemoine*. No one can believe in good faith that there is any difference in the meaning of the relevant language of the Statute or the Rules before, during or after the precedential opinion in *Lemoine*. There is nothing explicit or implicit in the proposed rulemaking for 37 CFR §41.31(a)(1) that suggests any change in 35 U.S.C. §134 or in the interpretation thereof as decided in *Lemoine*.

The Examiner repeatedly has been requested to identify the “new” language in 37 CFR §41.31(a)(1) that overrules *Lemoine* and clarifies 35 U.S.C. §134(a), and no response has been made by the Examiner except to say that his position remains as stated in the Advisory Action of August 14, 2006. The suggestion that the word “any” in 37 CFR §41.31(a)(1) means something completely different from what it meant in the Statute when *Lemoine* was decided is preposterous, especially when no legal or administrative authority whatsoever can be cited for support.

The O.G. Notices of September 7, 2004, pp. 1 – 137 is available on the PTO website, and includes a discussion of new Rule 41. Page 3 provides in part:

“A new part 41 consolidates rules relating to Board practice and simplifies reference to such practices.”

Page 31 of the O.G. Notices of September 7, 2004, provides in part:

“Sections 41.31(a) (1), (a) (2) and (a) (3) were proposed to generally incorporate the requirements of former Sec. 1.191(a) (2003) and to subdivide Sec. 1.191(a) into three parts to improve readability.”

Nothing in the history remotely suggests that Rule 41.31(a)(1) is anything more than a simple compilation of existing rules.

It entirely lacks merit to suggest that Rule 41.31(a) (1) has the effect of overruling a precedential Board decision that was approved by the Director and changes the meaning of 35 U.S.C. §134 as decided in *Lemoine*, when there is no suggestion whatsoever in the history of the proposed rulemaking or in the report on the final rule of that intent. Any Rule that was intended to have such a dramatic and unprecedented effect would have unambiguously set forth the intent and purpose of the Rule both in the proposed rulemaking and in the discussion of the final rule.

A Memorandum dated August 10, 2005 (TAB C), by Chief Administrative Patent Judge Michael R. Fleming of the Board of Patent Appeals and Interferences lists six precedential opinions of the Board in the Appendix, and one of the six is *Ex Parte Lemoine*, 46 USPQ2d 1420 (*Bd. Pat. App. & Int.* 1994). The date of the Fleming memorandum is nearly one year after the effective date of September 13, 2004, for 37 CFR §41.31, and it is absurd to suggest that Judge Fleming was unaware that *Lemoine* had been overruled by 37 CFR §41.31.

Brief History of These Applications

In parent application Serial No. 09/446,671 filed December 23, 1999, the Final Rejection dated March 14, 2002, rejected claims 81 – 87, 114 and 115 under 35 U.S.C. §112, ¶1&2, and under 35 U.S.C. §102(b) on U.S. Patent No. 5,490,732 to Hofmann et al.

First continuation application Serial No. 10/195,025 was filed on July 11, 2002, to continue prosecution of finally rejected claims 81 – 87, 114 and 115, as well as other claims, and the claims were revised, principally in an effort to overcome the rejection under 35 U.S.C. §112. In a Final Rejection dated July 16, 2003, claims 72 – 74 were rejected under 35 U.S.C. §112, ¶1&2, and under

35 U.S.C. §102(a) on U.S. Patent No. 5,490,732 to Hofmann et al. or U.S. Patent No. 5,603,554 to Monroe et al.

This second continuation application Serial No. 10/784,459 was filed on February 23, 2004, to continue prosecution of finally rejected claims 72 – 74, as well as other claims, and the claims were revised, principally by inserting reference numbers to the drawings in a bona fide attempt to overcome the rejections under 35 U.S.C. §112. The addition of reference numbers to the claims should not even be considered an amendment because MPEP §608.01(m) provides that the use of reference characters in the claims is to be considered as having no effect on the scope of the claims. In an Office Action dated October 31, 2005, claims 61 - 76, 80 and 81 were rejected under 35 U.S.C. §112, ¶1&2, and under 35 U.S.C. §102(e) on U.S. Patent No. 5,490,732 to Hofmann et al.

The initial Office Actions dated October 24, 2001, in Serial No. 09/446,671 and February 10, 2003, in Serial No. 10/195,025 also rejected claims to the same subject matter under 35 U.S.C. §112, ¶s 1 & 2, and under 35 U.S.C. §102(a) and 102(b) on Hofmann et al 5,490,732. Claims to the same subject matter have been rejected on the same grounds a total of five times.

While there is no requirement that the claims in the parent and continuation applications not differ in substance and scope for an appeal under 35 U.S.C. §134 and 37 CFR §41.31, the fact is that the claims involved here actually are of essentially the same substance and scope. Claims 61, 67 and 77 in this application are of essentially the same substance and scope as finally rejected claims 72, 73 and 74 in parent application Serial No. 10/195,025. Rejected claim 61 in this application is of essentially the same substance and scope as finally rejected claim 114 in Serial No. 09/446,671.

The rejection of claims five times on identical grounds in the three applications is itself uncontroverted evidence that the rejected claims do not differ in substance and scope. In any

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event, *Lemoine* decided that the claims in the parent and continuing applications do not have to be of essentially the same substance and scope to give an applicant the right to appeal under 35 U.S.C. §134 after a first rejection in the continuing application.

Respectfully submitted,



H. Duane Switzer
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901 Lakeside Avenue
Cleveland, OH 44114-1190
2216-586-7283

Date: Sept. 5, 2006

UNITED STATES CODE

1988 EDITION

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SUPPLEMENT V

CONTAINING THE GENERAL AND PERMANENT LAWS OF
THE UNITED STATES, ENACTED DURING THE
101ST AND 102^D CONGRESSES AND
103^D CONGRESS, FIRST SESSION

Prepared and published under authority of Title 2, U.S. Code, Section 285b,
by the Office of the Law Revision Counsel of the House of Representatives



JANUARY 3, 1989, TO JANUARY 24, 1994

VOLUME FIVE

TITLE 26—INTERNAL REVENUE CODE

TO

TITLE 37—PAY AND ALLOWANCES OF THE
UNIFORMED SERVICES

UNITED STATES
GOVERNMENT PRINTING OFFICE
WASHINGTON : 1994

in a country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Commissioner, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) **DEFINITION.**—As used in this section, the term "NAFTA country" has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act.

(As amended Dec. 8, 1993, Pub. L. 103-182, title III, § 331, 107 Stat. 2113.)

REFERENCES IN TEXT

Section 2(4) of the North American Free Trade Agreement Implementation Act, referred to in subsec. (b), is classified to section 3301(4) of Title 19, Customs Duties.

AMENDMENTS

1993—Pub. L. 103-182 amended section catchline and text generally. Prior to amendment, text read as follows: "In proceedings in the Patent and Trademark Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in sections 119 and 365 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States."

EFFECTIVE DATE OF 1993 AMENDMENT

Amendment by Pub. L. 103-182 applicable to all patent applications filed on or after Dec. 8, 1993, provided that applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in NAFTA country, except as provided in sections 119 and 365 of this title, that is earlier than Dec. 8, 1993, see section 335(b) of Pub. L. 103-182, set out as a note under section 1052 of Title 15, Commerce and Trade.

§ 105. Inventions in outer space

(a) Any invention made, used or sold in outer space on a space object or component thereof under the jurisdiction or control of the United States shall be considered to be made, used or sold within the United States for the purposes of this title, except with respect to any space object or component thereof that is specifically identified and otherwise provided for by an international agreement to which the United States is a party, or with respect to any space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space.

(b) Any invention made, used or sold in outer space on a space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space,

shall be considered to be made, used or sold within the United States for the purposes of this title if specifically so agreed in an international agreement between the United States and the state of registry.

(Added Pub. L. 101-580, § 1(a), Nov. 15, 1990, 104 Stat. 2863.)

EFFECTIVE DATE; SPECIAL RULES

Section 2 of Pub. L. 101-580 provided that:

"(a) **EFFECTIVE DATE.**—Subject to subsections (b), (c), and (d) of this section, the amendments made by the first section of this Act [enacting this section] shall apply to all United States patents granted before, on, or after the date of enactment of this Act [Nov. 15, 1990], and to all applications for United States patents pending on or filed on or after such date of enactment.

"(b) **FINAL DECISIONS.**—The amendments made by the first section of this Act [enacting this section] shall not affect any final decision made by a court or the Patent and Trademark Office before the date of enactment of this Act [Nov. 15, 1990] with respect to a patent or an application for a patent, if no appeal from such decision is pending and the time for filing an appeal has expired.

"(c) **PENDING CASES.**—The amendments made by the first section of this Act [enacting this section] shall not affect the right of any party in any case pending in a court on the date of enactment of this Act [Nov. 15, 1990] to have the party's rights determined on the basis of the substantive law in effect before such date of enactment.

"(d) **NON-APPLICABILITY.**—The amendments made by the first section of this Act [enacting this section] shall not apply to any process, machine, article of manufacture, or composition of matter, an embodiment of which was launched prior to the date of enactment of this Act [Nov. 15, 1990]."

CHAPTER 14—ISSUE OF PATENT

§ 156. Extension of patent term

(a) The term of a patent which claims a product, a method of using a product, or a method of manufacturing a product shall be extended in accordance with this section from the original expiration date of the patent if—

(1) the term of the patent has not expired before an application is submitted under subsection (d)(1) for its extension;

(2) the term of the patent has never been extended;

(3) an application for extension is submitted by the owner of record of the patent or its agent and in accordance with the requirements of paragraphs (1) through (4) of subsection (d);

[See main edition for text of (4) and (5)]

The product referred to in paragraphs (4) and (5) is hereinafter in this section referred to as the "approved product".

(b) Except as provided in subsection (d)(5)(F), the rights derived from any patent the term of which is extended under this section shall during the period during which the term of the patent is extended—

[See main edition for text of (1) to (3)]

As used in this subsection, the term "product" includes an approved product.

Suzanne
Young/JonesDay
Extension 6-1144 or
216-586-1144

To H. Duane Switzer/JonesDay@JonesDay

cc

bcc

09/02/2006 10:23 AM

Subject Re: 35 U.S.C. 134

History:

This message has been replied to.

Well, I think I have some good news:

The language of the 1994 edition uses "has" - that is, in the official United States Code 1994 ed., published by the Government Printing Office. So I would say that the 1994 language is consistent with the Code as it appears today.



NETSC132.PDF

The 1994 edition references two Public Laws (1952 and 1984), which I have attached here. The 1952 language is "has" and the 1984 amendment was a technical correction which does not mention this phrase.

see page 801 of the 1952 document, and page 3388 of the 1984 document.



PL 593 07-19-1952.pdf



PL 98-622 11-08-1984.pdf

I hope this helps!
Suzanne

H. Duane Switzer/JonesDay

H. Duane
Switzer/JonesDay
Extension 67283
09/01/2006 06:02
PM

To Suzanne Young/JonesDay@JonesDay

cc

Subject 35 U.S.C. 134

Hi Suzanne - Currently, 35 U.S.C. 134 provides in part "any of whose claims has been twice rejected". A 1994 decision (Ex parte Lemoine) quotes 35 U.S.C. 134 at that time as reading "any of whose claims have been twice rejected". I feel that "have" in the 1994 quote is a misquote or misprint. I found another quote that allegedly is from the 1994 35 U.S.C. 134 that uses "has" instead of "have". Can you obtain or find 35 U.S.C. 134 that was in effect in 1994? Preferably in some sort of form that proves or shows that it is what was in effect in 1994. We have a patent examiner who contends the Lemoine decision construing 35 U.S.C. 134 no longer applies because of the change from "have" to "has", & we would like to show that there has not been that actual change. Regards, Duane

[attachment "DOC087.PDF" deleted by Suzanne Young/JonesDay]

UNITED STATES CODE

1994 EDITION

CONTAINING THE GENERAL AND PERMANENT LAWS
OF THE UNITED STATES, IN FORCE
ON JANUARY 4, 1995

Prepared and published under authority of Title 2, U.S. Code, Section 285b,
by the Office of the Law Revision Counsel of the House of Representatives



VOLUME SEVENTEEN

TITLE 33—NAVIGATION AND NAVIGABLE WATERS
TO
TITLE 37—PAY AND ALLOWANCES OF THE UNIFORMED
SERVICES

UNITED STATES
GOVERNMENT PRINTING OFFICE
WASHINGTON : 1995



Page 666

Page 667

TITLE 35—PATENTS

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(2) July 6, 1916, ch. 225, § 1, 39 Stat. 345, 347-8, (3) Mar. 2, 1927, ch. 273, § 1, 44 Stat. 1335, (4) Aug. 7, 1939, ch. 568, 53 Stat. 1284).

The opening clause of the corresponding section of existing statute is omitted as having no present day meaning or value and the last two sentences are omitted for inclusion in section 267. The notice is stated as given or mailed. Language is revised.

CROSS REFERENCES

Abandonment of invention as denying patentability, see section 102 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 41, 267, 306 of this title.

§ 134. Appeal to the Board of Patent Appeals and Interferences

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(July 19, 1952, ch. 950, 66 Stat. 801; Nov. 8, 1984, Pub. L. 98-622, title II, § 204(b)(1), 98 Stat. 3388.)

HISTORICAL AND REVISION NOTES

Based on Title 35, U.S.C., 1946 ed., § 57 (R.S. 4909 amended (1) Mar. 2, 1927, ch. 273, § 5, 44 Stat. 1335, 1336, (2) Aug. 5, 1939, ch. 451, § 2, 53 Stat. 1212).

Reference to reissues is omitted in view of the general provision in section 251. Minor changes in language are made.

AMENDMENTS

1984—Pub. L. 98-622 substituted "Patent Appeals and Interferences" for "Appeals" in section catchline and text.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98-622 effective three months after Nov. 8, 1984, see section 207 of Pub. L. 98-622, set out as a note under section 7 of this title.

CROSS REFERENCES

Appeals to Commissioner from decisions of examiners on applications for registration of trade-marks, see section 1070 of Title 15, Commerce and Trade.

Board of Appeals, composition and duties, see section 7 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 141, 145, 154, 306 of this title.

§ 135. Interferences

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Commissioner may issue a patent to the ap-

plicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the Commissioner by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Commissioner, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Commissioner from determining patentability of the invention involved in the interference.

1700

MEMORANDUM

August 10, 2005

TO: Vice Chief Administrative Patent Judge
Administrative Patent Judges

FROM: MICHAEL R. FLEMING
Chief Administrative Patent Judge

**Michael
Fleming**

Digitally signed by Michael
Fleming
DN: CN = Michael Fleming, C =
US, O = Chief Judge, OU = BPAI
Date: 2005.08.11 17:12:33 -
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SUBJECTS: Standard Operating Procedure 2 (Revision 6)
Publication of opinions and binding precedent

The attached document supersedes Board of Patent Appeals and Interferences' Standard Operating Procedure 2 (Revision 5) dated August 11, 2004, on the same subject matter. The significant changes in this revision include:

- updating the SOP to reflect our new organizational structure;
- improving the readability of section VI Procedures For Adoption Of Binding Precedent
- allowing each judge a vote to determine whether an opinion is adopted as precedential.

Attachment

Cc: Amalia Santiago Chief Board Administrator

BOARD OF PATENT APPEALS AND INTERFERENCES
STANDARD OPERATING PROCEDURE 2 (REVISION 6)
PUBLICATION OF OPINIONS AND BINDING PRECEDENT

The following applies to the publication of opinions and adoption of binding precedent of the Board of Patent Appeals and Interferences (Board). This Standard Operating Procedure (SOP) creates internal norms for the administration of the Board. It does not create any legally enforceable rights. The procedures described in this SOP, as they pertain to determinations made by the Director, the Chief Administrative Patent Judge (Chief Judge) and any other Administrative Patent Judge (judge), are considered part of the deliberative process.

I. Background

- A. The Board annually issues roughly 3500 opinions in appeals, interferences and other proceedings. These opinions are written primarily for the benefit of the parties to the proceedings. Most opinions do not add significantly to the body of law.
- B. In the past, Board opinions have been officially published in the Official Gazette and the Decisions of the Commissioner of Patents, and other publications. Opinions have also been published in paper and electronic form by commercial organizations.
- C. Beginning in late 1997, opinions in support of final decisions of the Board of Patent Appeals and Interferences appearing in issued patents, reissue applications, reexamination proceedings and interference proceedings open to the public have been disseminated by way of the Board's Internet web page. The Internet address for these opinions is:

<http://www.uspto.gov/web/offices/dcom/bpai/bpai.htm>

- D. Opinions of the Trial Division have likewise been disseminated by way of links to the Board's web page. The Internet address for Trial Division opinions is:

<http://www.uspto.gov/web/offices/dcom/bpai/its.htm>

- E. Ultimately, the publication provisions of 35 U.S.C. § 122(b) are expected to result in publication of 80% of all patent applications. Because Board opinions on appeal in applications published pursuant to 35 U.S.C. § 122(b) will be disseminated by way of the Board's Internet web page, it is expected that 80% or more of all Board opinions will be published by the USPTO on the Board's Internet web page. It is likely that some of these opinions, as well as opinions not otherwise subject to publication by the USPTO, will also be published by commercial reporters.
- F. The availability of these opinions on the Board's Internet web page or from other

sources does not alter the fact that a Board opinion is precedential only if the opinion has been made precedential pursuant to the provisions of this or earlier versions of SOP 2. Public policy favors widespread publication of opinions, even if the opinions are not considered precedential.

- G. Nothing in this SOP should be construed as requiring a member of the public to seek permission under this SOP to submit any nonprecedential opinion of the Board in its possession to any commercial or other entity for publication. Any opinion made available to the public that does not expressly indicate that the opinion is binding precedent of the Board or is not identified as binding precedent in the Appendix to this SOP shall be deemed to be nonprecedential.

II. Categories Of Board Opinions

There shall be two categories of Board opinions:

1. Precedential opinions
2. Nonprecedential opinions.¹

III. Criteria For Identifying Candidates To Be Made Precedential

- A. The Board's policy shall be to limit opinions which are candidates for being made precedential to those meeting one or more of the following criteria:
1. The case is a test case whose decision may help expedite resolution of other pending appeals or applications.
 2. An issue is treated whose resolution may help expedite Board consideration of other cases or provide needed guidance to examiners or applicants pending court resolution.
 3. A new rule of law is established.
 4. An existing rule of law is criticized, clarified, altered or modified.
 5. An existing rule of law is applied to facts significantly different from those to which that rule has previously been applied.
 6. An actual or apparent conflict in or with past holdings of this Board is created, resolved, or continued.
 7. A legal issue of substantial public interest, which the Board has not treated recently, is resolved.
 8. A significantly new factual situation, likely to be of interest to a wide spectrum of persons other than the party (or parties) to a case is set forth.
 9. A new interpretation of a Supreme Court decision, a decision of the Court of Appeals for the Federal Circuit, or of a statute, is set forth.

¹ This category includes opinions of a merits or motions panel composed of all members of the Trial Procedures Section of the Trial Division when an interference assigned to the Trial Procedures Section involves a significant procedural issue applicable to proceedings before the Trial Procedures Section and the Trial Procedures Section judges deem it appropriate to issue an opinion binding on the Trial Procedures Section.

- B. The purpose of a precedential opinion is to create a consistent line of authority as to a holding that is to be followed in future Board decisions.
- C. Disposition by nonprecedential opinion does not mean that the case is considered unimportant, but only that a precedential opinion would not add significantly to the body of law.
- D. The Director, the Patents Operation acting through a Commissioner or Assistant Commissioner, the appellant, a third party member of the public, or any judge may request in writing that an opinion be made precedential, by forwarding that request, along with accompanying reasons, to the Chief Judge. Typically, this request should be received within 60 days after the opinion is issued. The request and subsequent response shall be filed separately from the official record.

IV. Procedures For Adoption Of Binding Precedent

- A. Any opinion of the Board satisfying one or more of the criteria identified in section III above may be adopted as precedential, either at the time of its entry or subsequent to entry, provided that the following steps are followed.
 - 1. A majority of the merits panel that is entering or has entered the opinion agrees that the opinion should be precedential.
 - 2. If the Chief Judge considers the opinion an appropriate candidate for being made precedential, the Chief Judge will circulate the opinion under consideration for designation as precedential to all of the judges.
 - 3. Within a time set in the notice circulating the opinion (typically two weeks from the date of the notice), each judge shall vote "agree" or "disagree" (without further written comment or written discussion) on whether that judge agrees that the opinion should be made precedential. Barring extended unavailability (as in the case of serious illness), each judge has an obligation to vote "agree" or "disagree." If a judge does not communicate a vote within the time set, then the judge's vote will be normally considered to be in agreement that the opinion be made precedential.
 - 4. If the Chief Judge considers that a sufficient majority of those voting agree that the opinion should be made precedential, the opinion (along with the numerical results of the vote) will be forwarded to the Director, or the General Counsel acting by delegation on the Director's behalf, for review. If the Chief Judge does not consider that a sufficient majority of those voting agree that the opinion should be made precedential, the opinion will not be forwarded for review.
 - 5. If the Director, or the General Counsel acting by delegation on the Director's behalf, agrees that the opinion should be made precedential, the Director or General Counsel will notify the Chief Judge of that determination.
 - 6. The opinion is then published or otherwise disseminated following notice and opportunity for written objection afforded by 37 CFR § 1.14, in those instances in which the opinion would not otherwise be open to public inspection.

- B. Opinions entered by expanded panels do not automatically become precedential, but instead are subject to the procedures of this SOP. However, a prior precedential decision of a prior panel of the Board may only be overturned by decision of an expanded panel that itself has been made precedential or pursuant to an event set forth in Section VI D. The authoring judge for any decision by an expanded panel shall call the Chief Judge's attention to the opinion prior to entry of the opinion so that consideration of whether the opinion shall be made precedential can occur in advance of entry.
- C. The Chief Judge will determine if the opinion is an appropriate candidate to be made precedential. If the Chief Judge is convinced that the opinion ought not to be made precedential (e.g., because the Chief Judge believes the opinion does not meet the criteria of Part III above), the Chief Judge is under no obligation to consult other judges.
- D. Where a written request for a precedential opinion has been received, the Chief Judge shall prepare an order indicating that the opinion has, or has not, been adopted as precedent of the Board under the procedures of this Standard Operating Procedure.
- E. The opinion will become precedential upon being published or otherwise disseminated.
- F. Clearance for publication, if needed under the rules, will be obtained by the Chief Judge.

V. Scope Of Director's And Chief Judge's Review

- A. The Director of the United States Patent and Trademark Office (USPTO) is both a statutory member of the Board (35 U.S.C. § 6(a)) and the official charged by statute with providing policy direction for the USPTO (35 U.S.C. § 3(a)(2)). The determination of which decisions or opinions shall have binding precedential affect on the USPTO generally is within the province of the Director's statutory policy role.
- B. Review by the Director, or the General Counsel acting by delegation on the Director's behalf, is not for the purpose of reviewing or affecting the outcome of any given appeal, but strictly for determining whether the given opinion is to be made precedential.
- C. Neither review by the Chief Judge, nor consultation with judges not assigned to the merits panel, is for the purpose of reviewing or affecting the outcome of any given appeal, but strictly for determining whether the given opinion is to be made precedential.

VI. Precedent Binding Upon The Board

- A. The following are considered precedent binding upon the Board:

1. An opinion of the Supreme Court.
 2. An *en banc* decision of the Court of Appeals for the Federal Circuit.
 3. A decision of the Court of Appeals for the Federal Circuit, or its predecessors, the Court of Customs and Patent Appeals (CCPA) and the Court of Claims, which the Court of Appeals for the Federal Circuit considers binding precedent. See *Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 765, 9 USPQ2d 1417, 1423 (Fed. Cir. 1988); *UMC Elecs. Co. v. United States*, 816 F.2d 647, 652 n.6, 2 USPQ2d 1465, 1468 n.6 (errata) (Fed. Cir. 1987), *cert. denied*, 108 S.Ct. 748 (1988); *South Corp. v. United States*, 690 F.2d 1368, 1370, 215 USPQ 657, 658 (Fed. Cir. 1982) (*en banc*).
 4. An opinion of the Board made precedential by the procedures contained in this or earlier versions of SOP 2.
- B. Judges encountering conflicts in the decisions of the Court of Appeals for the Federal Circuit, the CCPA, and/or the Court of Claims should call the conflict to the attention of the Chief Judge.
- C. All other opinions of the Board that are published or otherwise disseminated are not considered binding precedent of the Board.
- D. All judges, including the Chief Judge, are bound by a published or otherwise disseminated precedential opinion of the Board unless the decision supported by the opinion is (1) modified by the Court of Appeals for the Federal Circuit, (2) inconsistent with a decision of the Supreme Court or the Court of Appeals for the Federal Circuit, (3) overruled by a subsequent expanded panel, or (4) overturned by statute.

VII. Nonprecedential Opinions

- A. When authoring an opinion, a panel or a single judge may determine that the opinion may be published in a commercial reporter or not published in a commercial reporter. (Decisions on appeal in applications open to the public under the provisions of 35 U.S.C. § 122(b) will be published on the Board's Internet Web page without regard to the panel's or individual judge's determination.) The fact that a panel or judge determines that an opinion may be published in a commercial reporter does not mean that it must be published; it means only that the authoring panel or judge has no objection to its being published in a commercial reporter.
- B. When the panel or the judge has no objection to publication of the opinion in a commercial reporter, the opinion should contain the appropriate one of the following headings on the first page:

The opinion in support of the decision being
entered today is *not* binding precedent of the Board.

The opinion in support of the decision being entered today

is binding precedent of the Trial Procedure Section of the Board of Patent Appeals and Interferences. The opinion is otherwise *not* binding precedent of the Board.

- C. These headings will typically be used in situations where, although the opinion does not add significantly to the body of law, the opinion may nevertheless be helpful to more than just the parties involved, and where the opinion recounts the facts of the case and the legal authorities relied upon in a way that permits a full understanding of the issues and the board's determination by recourse to the opinion alone.
- D. When a panel does not consider publication of the opinion in a commercial reporter warranted, the opinion should contain the following heading on the first page:

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

- E. Any panel or judge seeking to have a non-precedential opinion published shall forward the opinion to the Chief Judge. Clearance, if needed under the rules, will be obtained by the Chief Judge consonant with 37 CFR § 1.14. After clearance required by the rules is obtained, or when clearance is not needed, the opinion will be published or otherwise disseminated.
- F. A non-precedential opinion that is published or otherwise disseminated is not binding on other judges and/or panels.

Appendix: Opinions Approved as Binding Precedent of The Board of Patent Appeals and Interferences pursuant to Standard Operating Procedure 2 which have not been modified or reversed by the Federal Circuit:

Reitz v. Inoue, 39 USPQ2d 1838 (Bd. Pat. App. & Int. 1995)
Ex parte Bhide, 42 USPQ2d 1441 (Bd. Pat. App. & Int. 1996)
Ex parte Lemoine, 46 USPQ2d 1420 (Bd. Pat. App. & Int. 1994)
Basmadjian v. Landry, 54 USPQ2d 1617 (Bd. Pat. App. & Int. 1997)
Ex parte Yamaguchi, 61 USPQ2d 1043 (Bd. Pat. App. & Int. 2001)
Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirmation No. 8229

Applicants	:	Allan Charles Webb, et al.
Serial No.	:	10/784,459
Filed	:	February 23, 2004
Title	:	COMPONENT ASSEMBLY WITH FORMED SPINDLE END PORTION
Group Art Unit	:	3682
Examiner	:	Lenard A. Footland
Attorney Docket No.	:	626220510021

REQUEST FOR RECONSIDERATION AND CLARIFICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Office Action dated June 6, 2006 indicates that the Appeal Brief filed March 29, 2006 is premature because none of the claims have been twice rejected, and cites 37 CFR §1.111. The Office Action further indicates that the Notice of Appeal filed on January 30, 2006 and the Appeal Brief filed on March 29, 2006 are not responsive to the Office Action dated October 31, 2006.

The above determinations by the Examiner clearly are in error and must be withdrawn so that the application can proceed to appeal.

This application is a continuation of U.S. Serial No. 10/195,025 filed July 11, 2002 and of U.S. Serial No. 09/446,671 filed December 23, 1999.

The claimed subject matter under rejection in this application was twice rejected in each of the '025 and '671 applications for a total of five rejections.

The right to appeal claims that have been twice rejected in 37 CFR §41.31(a)(2) includes rejections in parent applications of a continuation application. MPEP §1204 provides in part:

"A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice** rejected" does not have to be related to a particular application. >See *Ex Parte Lemoine*, 46 USPQ2d 1420, 1423 (Bd. Pat. App. & Inter. 1994) ("so long as the applicant has twice been denied a patent, an appeal may be filed")< For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant **>can choose< to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application."

The claims in the parent and continuing application do not have to be identical.


An argument by the dissent in *Lemoine* that the claims had to be of the same scope was rejected by the majority as follows at 46 USPQ2d 1423:

"The dissent also errs in construing 'any of whose claims has been twice rejected' to mean 'any of whose claims, which do not differ in substance and scope from previously rejected claims, has been twice rejected.' There is simply no support for this limited view in the statute."

"Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed."

The Office Action of June 6, 2006 should be withdrawn and the application permitted to proceed to appeal.

Respectfully submitted,


H. Duane Switzer
Reg. No. 22,431
Jones Day
North Point
901 Lakeside Avenue
Cleveland, OH 44114-1190
216-586-7283

Dated: June 9, 2006

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SEP 05 2006 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirmation No. 8229

Applicants : Allan Charles Webb, et al.
Serial No. : 10/784,459
Filed : February 23, 2004
Title : COMPONENT ASSEMBLY WITH FORMED
SPINDLE END PORTION
Group Art Unit : 3682
Examiner : Lenard A. Footland
Attorney Docket No. : 626220510021

SUPPLEMENTAL REQUEST FOR RECONSIDERATION AND CLARIFICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner's denial of applicants' right to appeal is contrary to 35 U.S.C. §134, contrary to 37 CFR §41.31, and contrary to the binding decision in *Ex Parte Lemoine*, 46 USPQ 2d 1420 (Bd. Pat. App. & Inter. 1994).

It is going on seven years that the subject matter of the claims under rejection in this application has been pending before the U.S. Patent and Trademark Office. The same claimed subject matter has been rejected on the same grounds in original application Serial No. 09/446,671 filed December 23, 1999, in first continuation application Serial No. 10/195,025 filed July 11, 2002, and in this second continuation application.

CLI-1437029v1

The application actually has been pending for more than nine years because it is based on International Application PCT/GB98/01823 filed June 22, 1998, which in turn is based on British Serial No. 9713343.3 filed June 24, 1997.

Counting the initial and final Office Actions in the two parent applications, and the initial Office Action in this application, claims to the same subject matter have been rejected five times on the same grounds, and the case is ripe for appeal.

The first Office Action in this continuation application is dated October 31, 2005, and rejected claims 61 – 76, 80 and 81 under 35 U.S.C. §112, ¶ 1 & 2, and under 35 U.S.C. §102(e) on U.S. Patent No. 5,490,732 to Hofmann et al.

Applicants appealed the rejection as permitted under 35 U.S.C. §134(a), because claims to the same subject matter in the two parent applications had been finally rejected on the same grounds.

In an Office Action dated June 6, 2006, the Examiner indicated that the appeal was premature because none of applicants' claims had been twice rejected. The Examiner cited 37 CFR §1.111 in support of his position, and held the appeal to be unresponsive to the rejection.

Applicants filed a Request for Reconsideration and Clarification on June 9, 2006, explaining that the claim rejections in the parent applications and in this application satisfy the requirement of twice rejected claims for filing an appeal under 35 U.S.C. §134(a) .

In a telephone conversation with the undersigned, the Examiner has indicated that the Request for Reconsideration and Clarification would be denied because it did not explain how the rejected claims in this application were the same, or similar, or not materially different from, the rejected claims in the parent applications.

It was pointed out to the Examiner, as it was in the original Request for Reconsideration and Clarification, that there is no requirement that the rejected claims in the parent and continuation applications be the same, or similar or not materially different. An argument by the dissent in

Lemoine that the claims had to be of the same scope was rejected by the majority as follows at 46

USPQ 2d 1423:

“The dissent also errs in construing ‘any of whose claims has been twice rejected’ to mean ‘any of whose claims, which do not differ in substance and scope from previously rejected claims, has been twice rejected.’ There is simply no support for this limited view in the statute.”

“Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed.”

The Board in *Lemoine* discussed whether the word “claims” in 35 U.S.C. §134 should be construed as referring to the claims of an application as in 35 U.S.C. §112, ¶2, or in a more general sense to refer to claims for a patent as used in 35 U.S.C. §132. The Board concluded that the word “claims” in 35 U.S.C. §134 is synonymous with a request or demand for a patent as used in 35 U.S.C. §132, and did not mean particular claims of an application. *Lemoine* at 1423.

After reflection and the apparent realization that the appeal is proper under 35 U.S.C. §134 as construed by *Lemoine*, the Examiner telephoned the undersigned to say that *Ex Parte Lemoine* no longer is binding because it was decided in 1994 and is superseded by 37 CFR §41.31 which became effective in 2004. The Examiner further indicated that in his opinion, 37 CFR §41.31 now requires that the claims in the parent and continuation applications must be *identical* to qualify as twice rejected claims under 35 U.S.C. §134.

The Examiner’s contentions are disingenuous. *Lemoine* construes 35 U.S.C. §134, and the Examiner’s contention that the Patent Office Rule supersedes or overrules the Statute is entirely without merit.

The language in 35 U.S.C. §134 and 37 CFR §41.31 is identical: “any of whose claims has been twice rejected.” The words mean the same thing in the Statute and the Rule, and that is the meaning explained by the Board in *Lemoine*.

There is nothing whatsoever in the proposed rulemaking to suggest that 37 CFR §41.31 was intended to attempt a change in the meaning of the statute or the decision in *Lemoine*. See Federal Register, Vol. 68, No. 228, pp 66648 – 66691. On the contrary, page 66649 provides in part:

“Proposed part 41 would better state the existing practice and should not be read to change the existing practice except as explicitly provided.”

The discussion of proposed 37 CFR §41.31 at page 66651 contains no suggestion of any attempt to change the meaning of 35 U.S.C. §134 or to overrule *Lemoine*, and there is no explicit provision in 37 CFR §41.31 that does so. The language of the Rule corresponds to the language of the Statute, as it must. If there were any inconsistencies between the Statute and the Rule, the Statute would control.

A brief history of the claimed subject matter in the three applications is provided here. In parent application Serial No. 09/446,671 filed December 23, 1999, the Final Rejection dated March 14, 2002, rejected claims 81 – 87, 114 and 115 under 35 U.S.C. §112, ¶1&2, and under 35 U.S.C. §102(b) on U.S. Patent No. 5,490,732 to Hofmann et al.

First continuation application Serial No. 10/195,025 was filed on July 11, 2002, to continue prosecution of finally rejected claims 81 – 87, 114 and 115, as well as other claims, and the claims were revised, principally in an effort to overcome the rejection under 35 U.S.C. §112. In a Final Rejection dated July 16, 2003, claims 72 – 74 were rejected under 35 U.S.C. §112, ¶1&2, and under 35 U.S.C. §102(a) on U.S. Patent No. 5,490,732 to Hofmann et al. or U.S. Patent No. 5,603,554 to Monroe et al.

This second continuation application Serial No. 10/784,459 was filed on February 23, 2004, to continue prosecution of finally rejected claims 72 – 74, as well as other claims, and the claims were revised by inserting reference numbers that refer to the drawings, principally in an effort to overcome the rejection under 35 U.S.C. §112. In an Office Action dated October 31, 2005, claims

61 - 76, 80 and 81 were rejected under 35 U.S.C. §112, ¶1&2, and under 35 U.S.C. §102(e) on U.S. Patent No. 5,490,732 to Hofmann et al.

The initial Office Actions dated October 24, 2001, in Serial No. 09/446,671 and February 10, 2003, in Serial No. 10/195,025 also rejected claims to the same subject matter under 35 U.S.C. §112, ¶'s 1 & 2, and under 35 U.S.C. §102(a) and 102(b) on Hofmann et al 5,490,732. Claims to the same subject matter have been rejected on the same grounds a total of five times.

It is inexplicable why the rejection on Hofmann et al. 5,490,732 is sometimes under 35 U.S.C. §102(a), sometimes under 35 U.S.C. §102(b), and sometimes under 35 U.S.C. §102(e), but the rejections are based on the same rationale. Furthermore, 35 U.S.C. §134 and *Lemoine* do not require that the rejections be the same.

While there is no requirement that the claims in the parent and continuation applications not differ in substance and scope for an appeal under 35 U.S.C. §134 and 37 CFR §41.31, the fact is that the claims involved here actually are of essentially the same substance and scope. The rejection of the claims in the three applications on the identical grounds itself suggests that the rejected claims in the three applications do not differ in substance and scope.

Rejected claims 61, 67 and 77 in this application are similar to finally rejected claims 72, 73 and 74 in parent application Serial No. 10/195,025. Rejected claim 61 in this application also is similar to finally rejected claim 114 in Serial No. 09/446,671.

The Examiner's determination that the appeal is premature and not responsive to the Office
Action of October 31, 2005, should be withdrawn.

Respectfully submitted,

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